THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte JOHN P. ELSON

_____

Appeal No. 98-0532
Application 07/996,382[1]

_____

HEARD: February 3, 1998

_____

Before ABRAMS, FRANKFORT and McQUADE, *Administrative Patent Judges.*

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

---

[1]Application for patent filed December 23, 1992. According to appellant, this application is a continuation of Application 07/824,069 filed January 23, 1992, now Reissue Patent No. 34,297, issued June 29, 1993, which is a reissue of U.S. Patent No. 4,895,496, issued January 23, 1990, based on Application 07/204,091 filed June 8, 1988.

This is an appeal from the decision of the examiner finally rejecting claims 37 through 56 of this reissue continuation application. These constitute all of the claims remaining of record.

The appellant's invention is directed to a refrigeration compressor. The claims before us on appeal can be found in an appendix to the appellant’s Brief.

BACKGROUND

The appellant filed a patent application on June 8, 1988, which issued as U.S. Patent No. 4,895,496 on January 23, 1990. Exactly two years later, on January 23, 1992, the appellant filed a reissue application which contained broadened claims. Notice of allowance of this reissue application was mailed on September 24, 1992, and it issued on June 29, 1993 as RE 34,297. According to the appellant, on December 14, 1992, it was discovered that an additional error existed which would not be cured by the reissue patent. As a result, on December 23, 1992, a second reissue application was filed, and it is this application which now is before us.

OPINION

Our understanding of the issue in this case is that claims 37 through 56 stand rejected as not being in compliance with 35 U.S.C. § 251 because they are not directed to an invention that is separate and distinct from that which is set forth in the reissue patent (Answer, pages 2 and 3). The appellant argues in rebuttal that the examiner has misconstrued the language and the intent of Section 251, and urges that a second reissue patent based upon an application that is a continuation of the first reissue application is not prohibited.

It is the examiner's position that although the second paragraph of 35 U.S.C. § 251 grants the Commissioner of Patents and Trademarks the discretion to issue several reissue patents under certain circumstances, this is limited in that

> multiple reissue patents can only[2] be issued on "separate and distinct parts of the thing patented" (Answer, page 6, underlining added).

That is, additional reissue applications are permitted only in the case of what normally would be the subject of divisional applications.

---

[2]"Only" does not appear in the statute; it is a product of the examiner's interpretation thereof.

We agree with the examiner that the granting of additional reissue patents for the purpose of covering separate and distinct inventions has specifically been addressed in Section 251. However, the examiner's conclusion that multiple reissue patents can be issued only for "separate and distinct parts of the thing patented" has specifically been repudiated by the Court of Appeals for the Federal Circuit. In *In re Graff*, 111 F.3d 874, 876, 42 USPQ2d 1471, 1473 (Fed. Cir. 1997), when considering the Board's affirmance of a final rejection of claims in a continuation reissue application for essentially the same reason as the instant case[3], our reviewing court stated that

> §251 does not bar multiple reissue patents in appropriate circumstances. Section 251[3] provides that the general rules for patent applications apply also to reissue applications, and §251[2] expressly recognizes that there may be more than one reissue patent for distinct and separate parts of the thing patented. **The statute does not prohibit divisional or continuation reissue applications, and does not place stricter limitations on such applications when they are presented by reissue**, provided of course that the statutory requirements specific to reissue

[3]The Board's decision on the propriety of the continuation reissue was, however, affirmed on the basis that it contained broadened claims which were filed more than two years after the date of the original patent.

> applications are met. *See* §251[3]. (42 USPQ2d at 1473, emphasis added).

The court continued that the second paragraph of Section 251 was intended as enabling, and not as limiting, and "places no greater burden on Mr. Graff's continuation reissue application than upon a continuation of an original application."

This, in our view, is dispositive of the issue before us. There is no dispute that the appellant's reissue patent was properly filed as a broadening reissue, and the reissue application now before us was properly filed as a continuation of the first, which at that time was a pending reissue application. As such, the continuation reissue application is entitled to the same treatment as a continuation application based upon an original application.

The rejection is not sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS)
Administrative Patent Judge)

CHARLES E. FRANKFORT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOHN P. McQUADE Administrative Patent Judge	)	

Appeal No. 98-0532
Application 07/996,382

Harness, Dickey & Pierce
P.O. Box 828
Bloomfield Hills, MI 48303